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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) HIT1P051/HSJ920030211US1
I hereby certify that this correspondence is being e-filed with the USPTO on <u>April 17, 2007</u> Signature <u>/April Skovmand/</u> Typed or printed <u>April Skovmand</u> name _____	Application Number 10/727,853	Filed 12/03/2003
First Named Inventor Donald Ray Gillis		
Art Unit 2728	Examiner Mohandes, Jila M.	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.		
This request is being filed with a notice of appeal.		
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <u>42,762</u> Registration number _____. <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____.		
<p style="text-align: right;">/Dominic M. Kotab/ _____ Signature Dominic M. Kotab _____ Typed or printed name 408-971-2573 _____ Telephone number April 17, 2007 _____ Date</p>		
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.		
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Arguments Accompanying Pre-Appeal Brief Request for Review

Submitted below are arguments specifying clear errors in the Examiner's rejections, or the Examiner's omission of one or more essential elements needed for a *prima facie* rejection.

Claims 1-5, 9-11, 14-16, 18-19 and 22

Claims 1-5, 9-11, 14-16, 18-19 and 22 have been rejected under 35 USC 102(b) as being anticipated by Jones (US5676245).

With respect to claim 1, the Examiner has relied on Figure 6 from Jones in an attempt to make a prior art showing of applicants' claimed "resiliently elastic material being adapted for suspending an electronic device with respect to the frame."

Specifically, the Examiner has referred to the base sheet 12 and the retaining sheet 14 from Jones in an attempt to make a prior art showing of applicants' "frame" and "resiliently elastic material," as claimed.

Applicants respectfully assert that Figure 6 in Jones clearly shows that "[t]he lap top computer 28 is secured and completely immobilized on the central base portion 39 of the base sheet 12 by the film tube material 14, which extends around the lap top computer 28" (see Col. 5, line 67 – Col. 6, line 3 – emphasis added). Thus, Jones fails to teach or disclose a "resiliently elastic material being adapted for suspending an electronic device with respect to the frame" (emphasis added), as claimed by applicants. Jones specifically teaches that the lap top is completely immobilized on the central base portion of the base sheet 12, and that the film tube material 14 extends around the lap top computer. Thus, the film tube material 14 in Jones does not suspend an electronic device with respect to the frame, as claimed by applicants, because the lap top computer in Jones is completely immobilized on the frame.

Claim 15 requires an elastic material coupled to the frame. However, Jones fails to specifically or inherently teach an elastic material coupled to the frame. In fact, in Col. 5, line 67 – Col. 6, line 3, Jones teaches that "[t]he lap top computer 28 is secured and completely immobilized on the central base portion 39 of the base sheet 12 by the film tube material 14, which extends around the lap top computer 28" (emphasis added). Thus, by disclosing that the lap top is completely immobilized on the central base portion 39 of the base sheet 12 by the film tube material 14, Jones suggests that the film tube material 14 is not elastic. Therefore, Jones fails to meet applicants' claimed "elastic material coupled to the frame."

The Examiner is reminded that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Therefore, it is applicants’ contention that not all claimed elements are overtly disclosed in Jones. Accordingly, because not all features of claims 1 and 15 are present in Jones, it appears that the Examiner may be implying that the undisclosed features are inherently present. However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Rather, to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Accordingly, reconsideration and allowance of claims 1 and 15 is respectfully requested.

Claims 2-5, 9-11, and 14 depend from claim 1, and therefore incorporate the limitations of claim 1. Thus, such claims are also believed to be allowable over Jones.

Further, claims 16, 18-19, and 22 depend from claim 15, and therefore incorporate the limitations of claim 15. Accordingly, claims 16, 18-19, and 22 are also believed to be allowable over Jones.

Claims 23 and 24

Claims 23 and 24 have been rejected under 35 USC 102(b) as being anticipated by Becker et al. (US6371434).

With respect to claim 23, the Examiner has relied on Figures 3-6 from Becker in an attempt to make a prior art showing of applicants' claimed "resiliently elastic ribs being coupled to an electronic device for suspending the electronic device with respect to the frame."

Applicants respectfully assert that Figures 3-6 from Becker clearly show that springs 10, 11, 12, and 13 are coupled to a rectangular supporting plate 2 and that "[c]ompact disc player 1 is located on top 25 of a rectangular supporting plate 2" (see Col. 4, lines 25-31). However, Becker clearly fails to teach or suggest that "resiliently elastic ribs [are] coupled to an electronic device" (emphasis added), as particularly claimed by applicants in claim 23.

Furthermore, with respect to claim 24, applicants claim a device "wherein a first of the ribs is coupled to a first side of the electronic device, wherein a second of the ribs is coupled to a second side of the electronic device, wherein a third of the ribs is coupled to a third side of the electronic device" (emphasis added). Thus, because Becker simply teaches that springs 10, 11, 12, and 13 are coupled to a rectangular supporting plate 2 and the compact disc player 1 is located on top of the rectangular supporting plate 2, Becker fails to teach ribs coupled to a first, second, and third side of an electronic device, as claimed by applicants. Therefore, Becker fails to meet all of applicants' claimed limitations. Accordingly, reconsideration and allowance of claims 23 and 24 is respectfully requested.

Claims 12-13 and 20-21

Claims 12-13 and 20-21 have been rejected under 35 USC 103(a) as being obvious over Jones.

The analysis of obviousness was set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). In order to establish a *prima facie* case of obviousness, three basic criteria must be met:

First, there must be some *suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of the references. Second, there must be a *reasonable expectation of success*. Finally, the prior art reference or combined references must teach or suggest *all the claim limitations*. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, and not based on applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991; emphasis added).

Claims 12-13 depend from claim 1. Applicants respectfully assert that the arguments made hereinabove regarding claim 1, apply to, and thus overcome the rejection of claims 12-13.

Specifically, the combination proposed in the rejection would fail at least the third element of the *Graham* test as applied to claim 1, and its dependent claims. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 1 requires that the resiliently elastic material is adapted for suspending an electronic device with respect to the frame. In sharp contrast, Jones teaches that the lap top is completely immobilized on the central base portion of the base sheet 12, and the film tube material 14 extends around the lap top computer (see Col. 5, line 67 – Col. 6, line 3). Thus, the film tube material 14 in Jones does not suspend an electronic device with respect to the frame, as claimed by applicants.

Claims 12-13 depend from claim 1, and therefore incorporate the limitations of claim 1. Accordingly, claims 12-13 are also believed to be allowable over Jones.

Similarly, claims 20-21 depend from claim 15. Applicants respectfully assert that the arguments made hereinabove regarding claim 15, apply to, and thus overcome the rejection of claims 20-21. Specifically, the combination proposed in the rejection would fail at least the third element of the *Graham* test as applied to claim 15, and its dependent claims. Accordingly, claims 20-21 are also believed to be allowable over Jones.

Claims 6-8 and 17

Claims 6-8 and 17 have been rejected under 35 USC 103(a) as being obvious over Jones. Specifically, the Examiner has stated that “it would have been an obvious matter of design choice to modify the shape of the elastic material, since such a modification would have involved a mere change in the shape of a component.”

Applicants respectfully disagree and assert that Jones requires a film tube material 14 which extends around an electronic device (see Col. 6, lines 2-3). In addition, Jones teaches that the base sheet and the lap top computer are inserted into the film tube material 14 (see Col. 5, lines 40-42 and Fig. 2). Thus, Jones requires a tube shaped material to slide the lap top and base sheet into. Therefore, Jones *teaches away* from deviating from a tube structure and using straps or ribs coupled to an electronic device, as claimed by applicants.

A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43

USPQ2d 1362, 1366 (Fed. Cir. 1997). It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Thus, because Jones inherently teaches away from using anything other than a tube structure, claims 6-8 and 17 are believed to be allowable over Jones.

Claims 25-26

Claims 25-26 have been rejected under 35 USC 103(a) as being obvious over Becker. Specifically, the Examiner has stated that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shock event time, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art.” Applicants respectfully disagree that such ranges, as claimed by applicants, could be discovered by one of only routine skill in the art.

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

In the present case, Becker discloses that “both the spring constants of the individual springs and the natural frequency of the system can be increased” such that “[a] component of elastic force applied in a specific direction is then always counteracted by a component of elastic force in the opposite direction” (Col. 2, lines 46-52), but gives no indication as to any effect on the “shock event time imparted on an electronic device,” as claimed by applicants. Further, no showing has been made that “extend[ing] a shock event time imparted on an electronic device coupled thereto by at least twice with respect to an identical shock imparted on an identical unprotected electronic device,” as claimed by applicants in claim 25, could be discovered by one of routine skill in the art. Further, in claim 26, applicants claim that “the device extends a shock event time imparted on an electronic device coupled thereto by at least four times with respect to an identical shock imparted on an identical unprotected electronic device” (emphasis added). Thus, because the ranges claimed by applicants could not be discovered by one of only routine skill in the art, nor are recognized in the art as a result effective variable, reconsideration and allowance of claims 25-26 is respectfully requested.